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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,149	11/30/2001	Hideo Neishi	09812.0578-00000	4641
22852	7590	09/05/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			KRAMER, JAMES A	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/998,149

Applicant(s)

NEISHI ET AL.

Examiner

James A. Kramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-12, 14-19, 21-23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-12, 14-19, 21-23, and 25-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/30/06 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 5-12, 14-19, 21-23, and 25-29 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claim one has been amended to include the following limitation, “the publication period indicating a period during which said presentation materials are stored in the presentation material publishing server.” Examiner has reviewed the Specification and cannot find support for this limitation. The “publication period” is discussed on the last paragraph of page 28, the second paragraph on page 31, the paragraph bridging pages 36 and 37 and with respect to figure 19, the third paragraph on page 41. Not one of these sections mentions that the

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publication period is defined by the “period during which said presentation materials are stored in the presentation material publishing server.”

Examiner notes that the Specification only teaches that the publication period is the period by which the materials are available to be downloaded. This is different from a system which would “un-store” or delete or purge the materials at the end of the publication period. Examiner further notes that such a limitation is inherent as there are various different ways to “deactivate” the presentation materials without deleting or purging them from the server.

If Applicant wishes this specific feature to be part of the claimed invention, Applicant must state on the record that such a feature would have been obvious to one of ordinary skill in the art at the time of the invention. Without such a statement on the record, Examiner believes that the Specification lacks written description for the newly added limitation.

In order to provide compact prosecution Examiner will interpret the claim in light of the specification. Namely, Examiner agrees with Applicant that there is a difference between the claimed and disclosed “publication period” and the “viewing period” of Chen. Specifically, Examiner agrees that the “publication period” of the present invention relates to the availability of the materials on the server, whereas the “viewing period” of Chen relates the time period by which each individual reader purchases the ability to view. As pointed out by Applicant on pages 13 and 14 of the amendment filed 6/30/06, the publication period is longer than the viewing period.

Based on this analysis, Examiner interprets “publication period” to be the period by which the presentation materials are active for downloading by the reader.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-12, 14-23 and 25-29, as interpreted by the Examiner are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. in view of Richardson (US Patent Application Publication Number 2002/0022962).

Chen et al. teaches a comprehensive system for producing and distributing on-demand presentations over a network (column 1; lines 19-20). Chen et al. teaches that elements of the presentation invention are included within a client-server system in which one or more presentation servers communicate with one or more clients. The clients transmit and receive data from the presentation servers over a variety of communication channel including local area networks or the Internet (column 2; lines 40-55) (The clients of Chen et al. represent the presenter and the reader; the presentation servers represents the presentation material publishing server which is accessed by the clients/presenter/reader via a network).

Chen et al. teaches implementing various types of business methods using the presentation system. In particular organizations may pay a one-time fee for the service and then end users or employees would not be charged to view the presentations. In another embodiment taught by Chen et al. end users would access the presentation on a pay-per-view basis (column 6; line 53 – column 7; line 20) (performing a credit process prior to uploading presentation

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material). Chen et al. teaches charging a fee to view over a specified period (column 7 ; lines 5-6)(public information contains publication period). Chen et al. further teaches maintaining a searchable database of on-demand presentations on the presentation server, in which stored presentations are categorized in an index, allowing users to search for a presentation on a particular topic (column 5; lines 22-30).

Chen et al. teaches an example of a user purchasing the right to view a particular presentation that identification information is stored on the computer in the form of a token or cookie (column 7; lines 42-53). Examiner notes that this corresponds to a membership registration means for registering for authorized access to presentation material publishing server.

Examiner notes that it is inherent to the system of Chen et al. that public information (defined by applicant on page 25; paragraph 2 of the specification as the presentation time of the materials, category information and downloading permission information”) be collected, as it is necessarily required to collect this information (such as category or permission data) in order to know how to charge the user to view the presentation and to allow the user to search by category. (User registration of a presenter is performed; public information contains at least category or browsing permissions). Additionally, Examiner notes that it is inherent and necessarily present in the invention of Chen et al. that the target address is notified to the presenter/client only after uploading is permitted, as it would make no sense to provide that address if the uploading were not permitted.

Chen further teaches different embodiments in which the users of the system pay fees for downloading (column 6; line 53 – column 7; line 6). Examiner notes specifically that a

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percentage of a fee paid for downloading paid to the content owner and the ODPO represents a download condition that is enter or negotiated by the content owner or presenter.

Chen further teaches “presentation content owner will pay ODPO to produce and/or host on-demand presentation.” Examiner notes that this clearly teaches that the servers of Chen store the data for some amount of time. However Chen does not specifically teach a “publication period” representing the period by which the presentation materials are active for downloading by the reader (as interpreted by the Examiner above).

Richardson teaches a method for maintaining a website. Specifically, Richardson teaches the posting of the website for a predetermined period and after the predetermined period deactivating the website (see for example paragraphs 0025, 0075, 0078 and 0087). Richardson teaches deactivation is useful in order to help receive compensation.

It would have been obvious to one of ordinary skill in the art to modify the interaction between the ODPO and the content owners of Chen to include a publication period representing the period by which the presentation materials are active for downloading by the reader as taught by Richardson in order to help to ODPO receive compensation for their hosting services.

***Response to Arguments***

Applicant's arguments with respect to "publication period" have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to "downloading of presentation material for storage as required by independent claims 1, 10 and 21" (see page 12, 3<sup>rd</sup> paragraph of remarks submitted 6/30/06) have been fully considered but they are not persuasive.

Examiner notes that Chen teaches various methods of presenting the presentation materials, including downloading, for storage (see for example column 4, lines 45-48).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (571) 272 6783. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

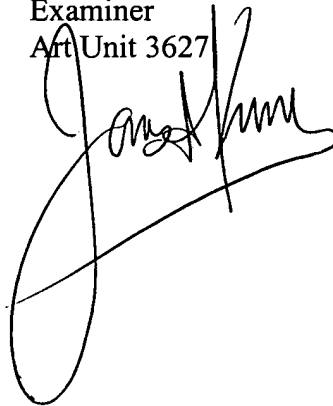
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272 6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James A. Kramer  
Examiner  
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A handwritten signature in black ink, appearing to read 'James A. Kramer', is written over the printed name and title.

jak  
8/30/06